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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	85867859
Applicant	Ana Rosa Neto Celestino Campina
Applied for Mark	CASA DO FADO
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Submission	Appeal Brief
Attachments	APPLICANT'S APPEAL BRIEF_CASA DO FADO_Design.pdf(205949 bytes)
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Date	09/14/2014

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
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)
APPLICANT:	ANA ROSA NETO)
	CELESTINO CAMPINA;)
	and)
	CARLOS ALBERTO)
	DAMIAÕ BARROQUEIRO)
)
SERIAL NO:	85,867,859)
)
FILED:	March 6, 2013)
)
MARK:	Casa do fado (& Design))
)
EXAMINING)
ATTORNEY:	Zachary R. Sparer)
)
LAW OFFICE:	115)
)
)

APPLICANT'S APPEAL BRIEF

Applicants, ANA ROSA NETO CELESTINO CAMPINA and CARLOS ALBERTO DAMIAÕ BARROQUEIRO, both citizens of Portugal (hereinafter "Applicant"), hereby appeal to the Trademark Trial and Appeal Board from the Examining Attorney's refusal of registration of the mark CASA DO FADO (& Design) of U.S. Trademark Application Serial Number 85,867,859.

FACTS OF THE CASE

Applicant's mark is CASA DO FADO (& Design), U.S. Trademark Application Serial No. 85/867,859, for use in connection with "Hotel and restaurant services" in International Class 43 ("Applicant's Mark"), depicted as follows:



Registration of Applicant's Mark was initially refused based on a finding of a likelihood of confusion with the following marks (collectively, the "Cited Marks"):

1. FADO (with large "accent") Reg. No. 2006347, for use in connection with "restaurant services" in International Class 43, with the mark depicted as follows:



2. FADO (& Design, with "accent"), Reg. No. 2019165, for use in connection with "restaurant services" in International Class 43, with the mark depicted as follows:



ISSUE TO BE DECIDED

Whether the Applicant's Mark is likely to cause confusion with the Cited Marks.¹

ARGUMENT

The Examining Attorney found that Applicant's Mark is similar to the Cited Marks because "applicant has merely added CASA DO to registrant's FADO mark" and "applicant's addition of a design element and stylized wording is not sufficient to avoid a likelihood of confusion". Office Action, June 18, 2013. Applicant respectfully disagrees. The Examining Attorney should have afforded the proper weight to the dominant and highly distinctive "Portuguese guitar" design and the additional wording "CASA DO" in Applicant's Mark. When properly *compared in their entireties*, including the dominant designs and additional wording, the marks are not similar in appearance, sound, meaning, or commercial impression. Accordingly, confusion is not likely.

The Marks are Not Similar

In the first part of the likelihood of confusion analysis, the marks are compared for similarities in their appearance, sound, connotation and commercial impression. TMEP §§1207.01, 1207.01(b). When comparing marks that share a literal element, the addition or deletion of other matter in the marks may be sufficient to avoid a likelihood of confusion if the marks in their entireties convey significantly different commercial impressions. TMEP §1207.01(b)(iii); *see, e.g., Bass Pro Trademarks, L.L.C. v. Sportsman's Warehouse, Inc.*, 89 USPQ2d 1844, 1857-58 (TTAB 2008) (finding that, although petitioner's and respondent's marks were similar by virtue of the shared descriptive wording "SPORTSMAN'S WAREHOUSE," this similarity was outweighed

¹ Applicant does not dispute the relatedness of the services at issue, which are "hotel and restaurant services" and "restaurant services"/

by differences in terms of sound, appearance, connotation, and commercial impression created by other matter and stylization in the respective marks); *Shen Manufacturing Co. v. Ritz Hotel Ltd.*, 393 F.3d 1238, 73 USPQ2d 1350 (Fed. Cir. 2004) (RITZ and THE RITZ KIDS create different commercial impressions); *In re Farm Fresh Catfish Co.*, 231 USPQ 495, 495-96 (TTAB 1986) (holding CATFISH BOBBERS (with "CATFISH" disclaimed) for fish, and BOBBER for restaurant services, not likely to cause confusion, because the word "BOBBER" has different connotation when used in connection with the respective goods and services); *In re Shawnee Milling Co.*, 225 USPQ 747 (TTAB 1985) (GOLDEN CRUST for flour held not likely to be confused with ADOLPH'S GOLD'N CRUST and design (with "GOLD'N CRUST" disclaimed) for coating and seasoning for food items).

Often, the examining attorney must determine whether a likelihood of confusion exists between composite marks that consist of a design element as well as words and/or letters. Frequently the marks at issue are similar in only one element. Although it is not proper to dissect a mark, if one feature of a mark is more significant than another feature, greater weight may be given to the dominant feature for purposes of determining likelihood of confusion. *Giant Food, Inc. v. Nation's Foodservice, Inc.*, 710 F.2d 1565, 218 USPQ 390 (Fed. Cir. 1983). While it is often true that the word portion of a mark is more likely to be impressed upon a purchaser's memory, that is not the case in every situation. The Court of Appeals for the Federal Circuit has cautioned that "[t]here is no general rule as to whether letters or designs will dominate in composite marks; nor is the dominance of letters or design dispositive of the issue." *In re Electrolyte Laboratories Inc.*, 929 F.2d 645, 647, 16 USPQ2d 1239, 1240 (Fed. Cir. 1990) (K+ and design for

dietary potassium supplement held not likely to be confused with K+EFF (stylized) for dietary potassium supplement); *Spice Islands, Inc. v. The Frank Tea & Spice Co.*, 505 F.2d 1293, 184 USPQ 35 (C.C.P.A. 1974) (SPICE TREE and tree design held not confusingly similar to SPICE ISLANDS and tree design, both for spices). Further, the visual impact of the marks on the minds of the prospective purchasers who view them must be considered and the design portion of a mark can be the dominant part of a mark. *Finn v. Cooper's Inc.*, 130 U.S.P.Q. 269, 272 (CCPA 1961) (emphasis added). Images create a lasting impression in the minds of consumers. *Id.* ("[We must consider the visual impact of the marks on the minds of the prospective purchasers who view them Symbolic marks speak a universal language; they lend themselves to effective display in advertising and sales promotional activity and can thus become the dominant part of the mark on labels, packages, and point of purchase displays. They can catch the eye of the customer and create a lasting general impression. Current mass advertising media utilize symbols which are visually projected into millions of homes of prospective purchasers by television and these symbols frequently are associated with pictures of the goods of a particular user").

Applying these principles, in *In re Fairview Imp. Corp.*, 2013 TTAB LEXIS 447 (TTAB Aug. 16, 2013, not precedential, opinion attached hereto as ***Exhibit A***), the Board recently reversed a refusal to register the following combined word/design mark:



for, *inter alia*, "sunglasses" in International Class 9 (with the descriptive term "collection" disclaimed) was not likely to cause confusion with the mark **HERITAGE 1981**, for, *inter alia*, "eyewear, namely, sunglasses" in International Class 9 (with "1981" disclaimed).

Despite the fact that the goods for both marks—sunglasses—were *identical*, and the marks shared the first term "Heritage" with the second terms "Collection" and "1981" disclaimed, the Board found that confusion was not likely because the "moose" design was "prominent" and contributed "greatly" to the visual impression of the applicant's mark:

[W]e note that applicant's mark Heritage Collection is similar to the mark HERITAGE 1981 in the cited registration solely to the extent that both contain the word HERITAGE as a prominent element thereof. However, the marks are dissimilar to a significant extent in that applicant's mark contains the prominently sized and arbitrary design of a moose. This design contributes greatly to the visual impression of applicant's mark. This is not a case in which the design portion of applicant's mark is an easily overlooked geometric carrier or an abstract pattern that is much smaller in size than the wording. We observe that in registrant's mark the term HERITAGE is the first and most prominent portion thereof. However, in applicant's mark, the term HERITAGE is located below the prominent moose design, which is equal in size to the wording HERITAGE COLLECTION and appears to be

arbitrary as applied to the goods. Even if consumers did not recognize the design as a moose per se, they nonetheless would be likely to recognize it as the design of an animal with a large rack of antlers. Thus, when viewed as a whole, applicant's mark is notably dissimilar from that of registrant in appearance.

In re Fairview, TTAB LEXIS 447 at 9-12. The Board further explained that even though the marks shared the first term "Heritage", which has similar connotations as applied to identical goods, **the sole fact that the mark contained a highly distinctive "moose" design was sufficient to obviate a likelihood of confusion:**

[T]he wording HERITAGE COLLECTION and HERITAGE 1981 are likely to have similar connotations as applied to identical or otherwise related goods. However, the arbitrary moose design does not appear to have any meaning or connotation as applied thereto, and thus creates an arbitrary and noticeable addition to the connotation engendered by applicant's mark. Taken as a whole, the marks thus are different in connotation and commercial impression.

Based upon the foregoing, we find that the dissimilarities between applicant's mark and the mark in the cited registration outweigh the similarities. Thus, the first *du Pont* factor regarding the dissimilarity of the marks favors applicant. Moreover, we find this factor is determinative and, despite the in-part identity of the goods, we conclude that the marks are sufficiently dissimilar that confusion is not likely between applicant's mark and the mark in the cited registration.

Id. at 11-12.

Turning to the present case, Applicant's Mark and the Cited Marks must be considered in their entirety—including the highly distinctive designs and stylized letters—and the Examining Attorney should have afforded proper weight to these features of the marks. Specifically, the Examining Attorney should have considered that Applicant's Mark contains a highly distinctive and dominant Portuguese guitar. Like the

"moose" design in *Fairview*, the Portuguese guitar dominates the entire mark and thus "contributes greatly" to the overall visual impression of the mark. *Id.* at 9. Next, like the term "Heritage" appearing in small letters below the "moose" design, the term "fado" appears in *small* letters below the dominant Portuguese guitar and is preceded by the highly distinctive terms "CASA DO", which means "house of" in Portuguese.² The addition of the terms "CASA DO" indeed changes the commercial impression of the marks— particularly in view of the highly stylized letters and visual differences between the design components of the marks. *See Bass Pro Trademarks, L.L.C. v. Sportsman's Warehouse, Inc.*, 89 USPQ2d 1844, 1857-58 (TTAB 2008) (finding that, although petitioner's and respondent's marks were similar by virtue of the shared descriptive wording "SPORTSMAN'S WAREHOUSE," this similarity was outweighed by differences in terms of sound, appearance, connotation, and commercial impression created by other matter and stylization in the respective marks). Further still, the Cited Mark FADO (& design with "accent") contains three distinctive Gaelic "spirals" which are completely dissimilar to Applicant's Portuguese guitar. Overall, the dominance of the Portuguese guitar and the small size of "fado" completely changes the marks in appearance.

Importantly, the terms fado and fado (with "accent") are completely different in meaning—particularly when accompanied by an image of a Portuguese guitar and Gaelic spirals, respectively. "Fado" is a well-known genre of Portuguese folk music that is synonymous with Portuguese culture. *See* Applicant's December 18, 2013, office action response, Wikipedia article discussing Fado music. Fado is typically played with a

² Applicant has entered a translation statement in the application indicating that CASA DO means "house of".

Portuguese guitar, and consumers would associate the Portuguese guitar with Portuguese fado music. In stark contrast, Fado (with "accent") is an Irish Gaelic term meaning "long ago", as evidenced by the translation statement entered for the Cited Marks. Consumers seeking Portuguese food and culture at a restaurant called "fado" will understand that "fado" evokes the atmospherics of Portuguese music and culture, and will not confuse Applicant with the Irish Gaelic term fado (with "accent"). The Gaelic "sprials" reinforce the differences between the cultures represented by the marks, and even the least sophisticated consumer will understand that Applicant's Portuguese and the Registrant's Irish restaurant services are not to be confused.

To be clear, Applicant does not argue any difference between the "restaurant services" recited in the application and registrations. Applicant recognizes that the restaurant services are identical as recited, and are therefore presumed to travel in all normal channels of trade, and are available to the same class of purchasers. However, the Examining Attorney should not assume that consumers will fail to distinguish the meanings of CASA DO FADO and FADO (with accent)—or at least notice that they are from different languages and may have different meanings when applied to restaurant services. Rather, when accompanied by a Portuguese guitar, consumers will not mistake Applicant's CASA DO FADO for an Irish restaurant, or the registrant's FADO with Gaelic spirals for a Portuguese restaurant. The distinctly different meanings of these terms weighs heavily against a finding of likelihood of confusion.

The marks are also different in sound, as Applicant's Mark contains the first and dominant terms "CASA DO" which are not present in the Cited Marks. Applicant's mark contains five (5) syllables, whereas the Registrant's marks contain only two (2) syllables.

These differences in sound, taken together with the clear differences in appearance, meaning, and overall commercial impression, weighs heavily against a finding of likelihood of confusion.

CONCLUSION

Based on the foregoing, there is no likelihood of confusion between Applicant's Mark and the Cited Marks. WHEREFORE, Applicant prays that the Examining Attorney's refusal of registration be reversed, and that Applicant's Mark be published for opposition.

Respectfully Submitted,

Dated: September 14, 2014

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EXHIBIT A

**THIS OPINION IS NOT
A PRECEDENT OF
THE TTAB**

Mailed: August 16, 2013

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Fairview Import Corp.

Serial No. 85395780

Gino Cheng of Orrick Herrington & Sutcliffe LLP for
Fairview Import Corp.

Seth A. Rappaport, Trademark Examining Attorney, Law Office
103 (Michael Hamilton, Managing Attorney).

Before Seeherman, Cataldo and Bergsman,
Administrative Trademark Judges.

Opinion by Cataldo, Administrative Trademark Judge:

On August 11, 2011 applicant, Fairview Import Corp.,
filed an intent-to-use application, under Section 1(b) of
the Trademark Act, 15 U.S.C. 1051(b), to register on the
Principal Register the mark displayed below for

cases for eyeglasses and sunglasses; cases for
spectacles and sunglasses; chains for spectacles
and for sunglasses; eyewear, namely, sunglasses,
eyeglasses and ophthalmic frames and cases
therefor; frames for spectacles and sunglasses;
lenses for sunglasses; spectacles and sunglasses;
sunglass lenses; sunglasses

in International Class 9.



"Color is not claimed as a feature of the mark." "The mark consists of a moose over the words 'Heritage Collection' in stylized lettering." In response to the trademark examining attorney's requirement, applicant disclaimed "COLLECTION" apart from the mark as shown.

The examining attorney refused registration under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), on the ground that applicant's mark, when applied to applicant's goods, so resembles the previously registered mark HERITAGE 1981 (in standard characters, 1981 disclaimed) for, inter alia, "eyewear, namely, sunglasses" in International Class 9.¹

¹ Registration No. 3447097 issued on June 10, 2008. The registration recites additional goods in Classes 14, 18 and 25 and services in Class 35.

When the refusal was made final, applicant appealed. Applicant and the examining attorney filed briefs on the issue under appeal.

Applicant argues at length that the marks are dissimilar; and that the cited registration issued over subsequently cancelled Registration No. 2467899 for the mark HERITAGE COLLECTION for "eyeglass frames and sun glasses," issued to a third party. In support of its contentions, applicant has made of record a copy of the cancelled registration discussed above, and a copy of additional cancelled third-party registrations for HERITAGE-formative marks for various goods including eyewear and other, unrelated goods and services. Applicant further submitted a definition of "moose" and internet articles discussing moose to support its argument that the moose design gives its mark a different connotation and commercial impression from the mark in the cited registration. Applicant also submitted copies of eleven live third-party registrations for marks that include the term HERITAGE for goods and services unrelated to those at issue herein. The following examples are illustrative:

Registration No. 3709988 for the mark HERITAGE
COLLECTION for greeting cards;

Registration No. 2102984 for the mark THE HERITAGE COLLECTION for various items of insulated tableware;

Registration No. 2740536 for the mark HERITAGE STORE for retail, mail order and online store services featuring natural and holistic foods, herbs and related products; and

Registration No. 3024079 for the mark THE HERITAGE and design of a colonial figure holding a golf club for clothing and golf tournaments.

The examining attorney maintains that the goods are identical in part and otherwise closely related, their trade channels are the same, and that the marks are similar. In support of his position, the examining attorney made of record approximately forty third-party registrations reciting sunglasses as well as additional goods identified in the involved application. In addition, the examining attorney made of record screenshots from four commercial internet sites at which both sunglasses and eyeglasses and eyeglass frames are offered for sale.

Our determination under Section 2(d) is based on an analysis of all of the probative facts in evidence that are relevant to the factors bearing on the issue of likelihood of confusion. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973). See also *In re Majestic Distilling Company, Inc.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). In any likelihood of

confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods. *See Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976) ("The fundamental inquiry mandated by §2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks").

We first turn to consider the *du Pont* factor regarding the similarity/dissimilarity between the goods. When comparing the goods, the respective identifications in the application and the cited registration control the analysis. *In re Giovanni Food Co.*, 97 USPQ2d 1990, 1991 (TTAB 2011). In this case, applicant does not argue that the goods are dissimilar. Indeed, registrant's goods are sunglasses and applicant recites sunglasses in three places in its identification of goods. Furthermore, based on the evidence made of record by the examining attorney, which suggests that sunglasses and eyeglasses, eyeglass frames, eyeglass chains and cases may emanate from a common source, we find that these goods are related. Thus, on the face of their respective identifications and evidence of record, applicant's goods are identical in part, and otherwise related, to those in the cited registration.

Because the goods are identical and/or closely related and there are no restrictions as to their channels of trade or classes of purchasers, we must assume that the goods are, or will be, sold in all the normal channels of trade to all the usual purchasers for such goods, and that, at least with respect to the identical goods, sunglasses, the channels of trade and the purchasers for applicant's and registrant's goods would be the same. *See Interstate Brands Corp. v. McKee Foods Corp.*, 53 USPQ2d 1910 (TTAB 2000).

The identity in part and otherwise close similarity between the goods, trade channels and classes of purchasers are factors that weigh in favor of a finding of likelihood of confusion.

The coexistence of the cited registration with the earlier, subsequently cancelled third-party Registration No. 2467899 for the mark HERITAGE COLLECTION for "eyeglass frames and sun glasses," is of limited probative value. On this record, we do not know the circumstance surrounding the registration of these marks, or any relationship or agreements that may exist between the owners thereof. Further, it is settled that expired or cancelled registrations are of no probative value. *See Action Temporary Services Inc. v. Labor Force Inc.*, 870 F.2d 1563,

10 USPQ2d 1307, 1309 (Fed. Cir. 1989) ("[A] cancelled registration does not provide constructive notice of anything").

Next, we consider applicant's evidence of live third-party registrations for HERITAGE COLLECTION and HERITAGE-formative marks. It is settled that the registrations are not evidence of use of the marks shown therein. Thus, they are not proof that consumers are familiar with such marks so as to be accustomed to the existence of the same or similar marks in the marketplace. See *Smith Bros. Mfg. Co. v. Stone Mfg. Co.*, 476 F.2d 1004, 177 USPQ 462 (CCPA 1973); and *Richardson-Vicks, Inc. v. Franklin Mint Corp.*, 216 USPQ 989 (TTAB 1982). The Federal Circuit has made it clear that:

The probative value of third-party trademarks depends entirely upon their usage. *E.g., Scarves by Vera, Inc. v. Todo Imports, Ltd.*, 544 F.2d 1167, 1173 (2d Cir. 1976) ("The significance of third-party trademarks depends wholly upon their usage. Defendant introduced no evidence that these trademarks were actually used by third parties, that they were well promoted or that they were recognized by consumers.")... As this court has previously recognized where the "record includes no evidence about the extent of [third-party] uses ... [t]he probative value of this evidence is thus minimal." *Han Beauty, Inc. v. Alberto-Culver Co.*, 236 F.3d 1333, 1338 (Fed. Cir. 2001) (emphasis added).

Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772, 396 F.3d 1689, 73 USPQ2d 1689, 1693 (Fed. Cir. 2005).

Here, applicant has presented no evidence of use so we must accord this evidence limited weight. We further note that the third-party registrations recite a broad range of goods and services that are unrelated to those identified in the involved application and cited registration. Nonetheless, it is proper to consider these types of registrations in the same manner as dictionary definitions. *In re Box Solutions Corp.*, 79 USPQ2d 1953, 1955 (TTAB 2006) ("[T]hird-party registrations can be used in the manner of a dictionary definition to illustrate how a term is perceived in the trade or industry"). See also *In re J.M. Originals Inc.*, 6 USPQ2d 1393, 1394 (TTAB 1987) ("[T]hird party registrations are of use only if they tend to demonstrate that a mark or a portion thereof is suggestive or descriptive of certain goods and hence is entitled to a narrow scope of protection"). In this case, the third-party registrations for HERITAGE COLLECTION and other HERITAGE-formative marks suggests that the term HERITAGE possesses a suggestive significance that others have recognized in adopting the term in their marks. We find, as a result, that the term HERITAGE is not a term with

strong source-identifying significance, and that the cited registration is accordingly entitled to a narrower scope of protection.

We turn then to the *du Pont* factor focusing on the similarity or dissimilarity of the marks in their entirety as to appearance, sound, connotation and commercial impression. *In re E. I. du Pont De Nemours & Co.*, 177 USPQ at 567. In comparing the marks, we are mindful that the test is not whether the marks can be distinguished when subjected to a side-by-side comparison, but rather whether the marks are sufficiently similar in terms of their overall commercial impression so that confusion as to the source of the goods offered under the respective marks is likely to result. *San Fernando Electric Mfg. Co. v. JFD Electronics Components Corp.*, 565 F.2d 683, 196 USPQ 1, 3 (CCPA 1977); and *Spoons Restaurants Inc. v. Morrison Inc.*, 23 USPQ2d 1735, 1741 (TTAB 1991), *aff'd unpublished*, No. 92-1086 (Fed. Cir. June 5, 1992).

In this case, we note that applicant's mark



is similar to the mark HERITAGE 1981 in the cited registration solely to the extent that both contain the word HERITAGE as a prominent element thereof. However, the marks are dissimilar to a significant extent in that applicant's mark contains the prominently sized and arbitrary design of a moose. This design contributes greatly to the visual impression of applicant's mark. This is not a case in which the design portion of applicant's mark is an easily overlooked geometric carrier or an abstract pattern that is much smaller in size than the wording. We observe that in registrant's mark the term HERITAGE is the first and most prominent portion thereof. However, in applicant's mark, the term HERITAGE is located below the prominent moose design, which is equal in size to the wording HERITAGE COLLECTION and appears to be arbitrary as applied to the goods. Even if consumers did not recognize the design as a moose per se, they nonetheless would be likely to recognize it as the design of an animal

with a large rack of antlers. Thus, when viewed as a whole, applicant's mark is notably dissimilar from that of registrant in appearance.

With regard to the overall impression conveyed by the marks, we note that the meaning or connotation of a mark must be determined in relation to the recited goods. See *In re Sears, Roebuck and Co.*, 2 USPQ2d 1312 (TTAB 1987); and *In re British Bulldog, Ltd.*, 224 USPQ 854 (TTAB 1984). In this case, the wording HERITAGE COLLECTION and HERITAGE 1981 are likely to have similar connotations as applied to identical or otherwise related goods. However, the arbitrary moose design does not appear to have any meaning or connotation as applied thereto, and thus creates an arbitrary and noticeable addition to the connotation engendered by applicant's mark. Taken as a whole, the marks thus are different in connotation and commercial impression.

Based upon the foregoing, we find that the dissimilarities between applicant's mark and the mark in the cited registration outweigh the similarities. Thus, the first *du Pont* factor regarding the dissimilarity of the marks favors applicant. Moreover, we find this factor is determinative and, despite the in-part identity of the goods, we conclude that the marks are sufficiently

dissimilar that confusion is not likely between applicant's mark and the mark in the cited registration. *Kellogg Co. v. Pack'em Enterprises Inc.*, 951 F.2d 330, 21 USPQ2d 1142 (Fed. Cir. 1991).

Decision: The refusal to register is reversed.

Opinion by Bergsman, Administrative Trademark Judge,
dissenting:

I respectfully dissent because I find that the marks are similar and, therefore, their use on in part identical and otherwise closely related products is likely to cause confusion.

Based on this record, there is insufficient evidence to support the majority's finding that the cited registration is entitled to a narrow scope of protection. As the majority notes, there is no evidence of third-party use and none of the third-party registrations are related to eyewear. Further, because HERITAGE 1981 has been registered and is not subject to a petition for cancellation, the registration is entitled to the presumptions accorded by Section 7(b) of the Trademark Act, 15 U.S.C. § 1057(b) (*i.e.*, prima facie evidence of the validity of the registered mark and of the registration of the mark, of the ownership of the mark, and of the owner's

exclusive right to use the registered mark in commerce on or in connection with the goods or services specified in the registration). Thus, the registered mark HERITAGE 1981 must be viewed as suggestive at worst. As indicated above, the record does not show that the cited mark is so highly suggestive that its scope of protection or exclusivity of use should be limited when it is compared with similar marks on in part or closely related products.

Further, even if I agreed that HERITAGE 1981 is an inherently weak mark, that would not be fatal to finding likelihood of confusion because even weak marks are entitled to protection against confusion. *King Candy Co. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108, 109 (CCPA 1974).

In comparing the marks, where, as here, the goods are in part identical and otherwise closely related, the degree of similarity necessary to find likelihood of confusion need not be as great as where there is a recognizable disparity between the goods. *Century 21 Real Estate Corp. v. Century Life of America*, 970 F.2d 874, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992); *Jansen Enterprises Inc. v. Rind*, 85 USPQ2d 1104, 1108 (TTAB 2007); *Schering-Plough HealthCare Products Inc. v. Ing-Jing Huang*, 84 USPQ2d 1323, 1325 (TTAB 2007).

In considering applicant's mark, I see no reason to depart from the practice of giving greater weight to the word portion of a mark because the words would be used by consumers to request the products. *In re Dakin's Miniatures, Inc.*, 59 USPQ2d 1593, 1596 (TTAB 1999); *In re Appetito Provisions Co.*, 2 USPQ2d 1553, 1554 (TTAB 1987). See also *Sweats Fashions Inc. v. Pannill Knitting Co.*, 833 F.2d 1560, 4 USPQ2d 1793, 1798 (Fed. Cir. 1987); *Giant Food, Inc. v. Nation's Food Service, Inc.*, 710 F.2d 1565, 218 USPQ 390 (Fed. Cir. 1983).

In view of the foregoing, I find that the dominant element of both marks is the word "Heritage." In the registered mark HERITAGE 1981, "1981" will be considered the year registrant was established and it has little source indicating significance. Likewise, the word "Collection" in applicant's mark will be considered as the works of a particular designer and it has little source indicating significance.² Thus, consumers will believe that that applicant's HERITAGE COLLECTION with the moose design is a variation of the HERITAGE 1981 eyewear line.

² *Thefreedictionary.com* derived from the Random House Hernerman Webster's College Dictionary (2010). The Board may take judicial notice of dictionary definitions, *Univ. of Notre Dame du Lac v. J.C. Gourmet Food Imp. Co.*, 213 USPQ 594 (TTAB 1982), *aff'd*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983), including online dictionaries that exist in printed format or have regular fixed editions. *In re Red Bull GmbH*, 78 USPQ2d 1375, 1377 (TTAB 2006).

In view of the foregoing, I find that applicant's mark HERITAGE COLLECTION and design for "cases for eyeglasses and sunglasses; cases for spectacles and sunglasses; chains for spectacles and for sunglasses; eyewear, namely, sunglasses, eyeglasses and ophthalmic frames and cases therefor; frames for spectacles and sunglasses; lenses for sunglasses; spectacles and sunglasses; sunglass lenses; sunglasses" so resembles the mark HERITAGE 1981 for "eyewear, namely, sunglasses" as to be likely to cause confusion. Therefore, I would affirm the refusal to register.